

Appl. No. 10/590,264
Response dated January 16, 2008

PATENT APPLICATION
Docket No. 36157/8 (formerly 36157/1.9) (US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. 10/590,264
Applicant: Paul A. Kohl, et al.
Title: MICROSTRUCTURE AND METHODS OF FABRICATION THEREOF
Filed: August 18, 2006
Docket No. 36157/8 (formerly 36157/1.9)

Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

RENEWED REQUEST UNDER 37 C.F.R. 1.497(d)

TO THE COMMISSIONER FOR PATENTS

This paper is submitted in response to the Commissioner of Patents' DECISION ON REQUEST UNDER 37 CFR 1.497(d). The request sought to delete an inventor from the application.

There are four requirements under 37 CFR 1.497(d):

- (1) A statement from each . . . person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention.
- (2) The processing fee set forth in §1.17(i)
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee; and
- (4) Any new oath or declaration required by (f) of this section

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The Decision states that Items (1) and (2) have been satisfied by the original previously filed request. Further, the Decision states that Item (4) does not apply to the present application. Accordingly, submission of this paper and accompanying documents seeks to satisfy Item (3).

The Decision dismisses the request without prejudice on the grounds that the assent of the assignee to change inventorship was not submitted with the request. Among the requirements to file a request to correct inventorship, the applicant must submit the written consent of any assignee. 37 C.F.R. 1.497(d). The Commissioner's response recognizes that no assignment has been recorded for the U.S. application, but concludes that the filing of the international application by a corporate applicant implies that such an assignment may exist.

The Decision also states that the declaration filed 25 June 2007, filed in response to the Notification Of Missing Requirements, was (a) defective for failure to properly identify the inventors of record and (b) an unacceptable compilation of multiple declarations.

Applicant renews the request under 37 C.F.R. 1.497(d) for the above-identified application. An inventorship error occurred in the above-identified application without deceptive intention on the part of the inventors or the Assignee. Therefore, correction of inventorship is requested by deleting the following inventor: **Justin Tullis**

Enclosed are:

1. a declaration in compliance with 37 C.F.R. §1.497(a) and (b)
2. an executed ASSIGNMENT designating Georgia Tech Research Corporation as Assignee
3. a statement that the Assignee, Georgia Tech Research Corporation, consents to deleting the above named inventor pursuant to 37 C.F.R. §1.497(d)

Item 1 should be a satisfactory response to the Notification Of Missing Requirements of 23 March 2007. Items 2 and 3 should satisfy the final requirement for the request under 37 CFR 1.497(d)

The application is now believed to be complete and ready for examination. If the Office of PCT Legal Administration has further questions regarding this issue, please contact the undersigned.

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Respectfully submitted,

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Date: January 16, 2008

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